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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/818,520 03/14/97 FARQUHAR

J F97.0500-R

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IM22/1107

EXAMINER

YAO, S

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 11/07/00

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 08/818,520
Filing Date: March 14, 1997
Appellant(s): Farquhar et al

Mr. Robert Barrett
For Appellant

MAILED

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GROUP 1700

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 09-25-00.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is substantially correct. In the appendix, claims 15 and 21 should be deleted, because these claims were cancelled in Paper No. 20. The rejection of claim 28 has been withdrawn.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct. It should be noted, however, that issue I is a petitional issue, but not an appealable issue. Examiner's response to Appellant's argument regarding this matter will be made once Appellant's petition is received.

(7) *Grouping of Claims*

Appellant's brief includes a statement that all claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Note: there is no listing of prior art. The art rejection in this application has been withdrawn.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7-14, 16-20, and 22-27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 7, the claim recitation of having at least one finger on first and second sides raises an issue of New Matter. The original disclosure teaches providing 1st and 2nd sides of the metal covers with multiple fingers (see element 26 of figure 3). There is no suggestion in the original disclosure of using a finger on 1st and 2nd sides. In fact, in two separate declarations made by Mr. Paul Mercadante and Mr. Mark Moshayedi in Application No. 08/092,012 (now U.S. Patent 5,397,857) Paper No. 7, it was stated in numbered paragraph 4 that "*Duel's product's superiority over the other available products is due to the unique construction of the cover halves which interperses a plastic frame within the metal elements or cover. This allows assembly of the package far more rapidly than with other products, and yields a superior*

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package result.” (emphasis added). If there is only a finger on the 1st and 2nd sides of the cover, how can each cover interperes a plastic frame? Moreover, Appellant also argues in Paper No. 6 on pages 3-4 in application ‘012, the critically of “*protruding metallic fingers*” to the invention as evidence from the following passage “*The technique includes the use of protruding metallic fingers on the cover ... The present invention accomplishes this by means of the multiple fingers 26 ...*” (emphasis added).

In claims 9 and 16, the recitation of having fingers from at least two sides also raises an issue of New Matter. These claims read on having fingers on all sides of the metallic cover. As clearly illustrated in figure 3, only the 1st and 2nd sides of each cover are provided with fingers. . It should be noted that, in column 3 lines 27-28 of U.S. Patent ‘857, it discloses “... metal fibers 26 are provided on each side of the covers 12 & 14.”. One in the art, reading this passage in the context of figures 2 and 3 as disclosed in column 3 lines 12-28, would not reasonably conclude that the original disclosure teaches providing fingers on all sides of each cover.

In claim 11, the claim recitation of “*with at least one finger extending from each said sides of each cover*” raises an issue of New Matter for the same reasons set forth above.

In claim 17, the claim recitation of “the edge of the metal cover is bent ...” raises an issue of New Matter. The original disclosure does not provide sufficient support to require a singular edge being bent. More important, it is unclear how this claim further limit claim 11. Claim 11 requires multiple edges to be bent.

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In claim 18, this claim now requires only one edge, instead of multiple edges, to be bent to conform to a shape of a frame. In addition, this claim does not also require having fingers extending from each of 1st and 2nd sides. Equally important, the second package half does not even require having any edge to be bent to conform to a shape of the frame and require having fingers extending from the sides of second package half. In other words, the recited second package half reads on a flat metal sheet with a molded frame bonded to it. The presently recited limitations of this claim do not have sufficient support in the original disclosure.

In claims 22-23, the claims recitation of "*a finger extends ... the frame element is injection molded partially around the edge*" (emphasis added) raise an issue of New Matter. The original disclosure may provide support for generically requiring a frame element to be injection molded around the edges or fingers. However, there is suggestion that Appellant has in possession of ONLY injection molding a frame element "*partially around the edge*". In fact, figure 4 shows that the edge is fully embedded by the injection molded frame element.

In claim 24, the limitations in this claim reads on having fingers to all sides of each cover. There is no sufficient support in the original disclosure for this embodiment. As noted above, figure 3 clearly shows that only the 1st and 2nd sides of each cover are provided with fingers.

In claim 25, according to Appellant on page 9 in the Appeal brief, the claimed language "*means for securing ...*" encompasses, "*A variety of equivalents to the disclosed means structure could be imagined, for example, first and second covers do not need to be bent to conform to the shape of the corresponding first and second frame elements or they can be partially bent to*

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conform, or only one of the elements needs to be bent to conform.” (emphasis added); and then on page 20, Appellant further states that the equivalence of the disclosed structure can also be those that “... *do not include fingers and have a bent cover; perhaps only have one finger on each side of the cover; or the covers are bent but are not bent to conform to the frames or wherein only one of the covers is bent.*” (emphasis added). The disclosure of the application relied upon does not reasonably convey to the artisan that the inventor had possession at that time of the later claimed subject matter of: a) not requiring multiple fingers on the 1st and 2nd sides; b) not requiring multiple edges to be bent; c) requiring partially bent edges; d) requiring edges to be bent, but without requiring, the edges to be bent to conform to the frames; and, e) requiring only one of the covers to be bent.

In claim 26, the limitation in this claim does not require multiple fingers. This raises an issue of new Matter for reasons set forth above.

In claim 27, the limitation in this claim reads of having fingers on all sides of each cover. This raises an issue of new Matter for reasons set forth above.

Claims 7-14, 16-20, 22-23 and 25-27 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application

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for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

To determine whether there is an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based, it is imperative to review the record of the parent (S.N. 08/092,102) of this reissue application as a whole. In other words, one must review the cumulative limitations added to the claims as well as Appellant's arguments to determine whether there is an improper recapture of claimed subject matter. In an examiner's amendment in S.N. 08/092,102, a limitation requiring "*each cover having a first side and a second side with a plurality of fingers extending from said sides and wherein edges of the metal covers are bent to conform to the shape of the frame and said fingers are embedded in*" (emphasis added) was added to independent claim 16 to place the application in condition for allowance. In addition, in response to Examiner's office action, Appellant amended the claim in amendment B in Application '102 Paper No. 6, to include "*the plastic frame elements being injection molded around a plurality of fingers*" (emphasis added), and then argues on pages 3-4 the criticality of injection molding and "protruding metallic fingers" to the invention as evidence from the following passage "*The technique includes the use of protruding metallic fingers on the cover ... The present invention accomplishes this by means of the multiple*

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fingers 26 ...” (emphasis added). To further emphasize the importance of using multiple fingers, Appellant further submitted two separate declarations made by Mr. Paul Mercadante and Mr. Mark Moshayedi in Application ‘102 Paper No. 7. In both declarations, it was stated in numbered paragraph 4 that *“Duel’s product’s superiority over the other available products is due to the unique construction of the cover halves which interperses a plastic frame within the metal elements or cover. This allows assembly of the package far more rapidly than with other products, and yields a superior package result.”* (bold face and emphasis added).

As for independent claims 7 and 11, these claims do not require multiple fingers.

As for independent claim 18, even without considering the record of Application ‘102 as a whole, and only relying on Appellant’s own admission on page 21 full paragraph 1, it is readily apparent that there an improper recapture of claimed subject matter. According to Appellant, the limitation of having *“edges of the metal covers [being] bent to conform to the shape of the frame”* (insertion in original; emphasis added) was the one which place the application in condition for allowance. Note this limitation requires multiple edges of multiple covers are bent. However, claim 18 only requires one edge, instead of multiple edges, to be bent to conform to a shape of a frame. Equally important, the second package half does not even require having any edge to be bent to conform to a shape of the frame and require having fingers extending from the sides of second package half (i.e. this reads on a flat metal sheet). However, the limitation which place the application in condition for allowance requires multiple edges being bent for both covers. Moreover, this claim does not also require having fingers extending from each of 1st and

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2nd sides which was deemed critical to the invention by Appellant in Application '102 as noted above.

As for claim 25, even without considering the record of Application '102 as a whole, and only relying on Appellant's own admission on page 21 full paragraph 1, it is readily apparent that there an improper recapture of claimed subject matter. According to Appellant's own admission on page 21, "... the bent edges of the metal covers was the limitation that resulted in allowance of the claims over the prior art." (bold face and emphasis added). Note that the added limitation requires having multiple edges being bent for both covers not just one of the covers. However, according to Appellant on page 9 in the Appeal brief, the claimed language "*means for securing ...*" encompasses "*A variety of equivalents to the disclosed means structure could be imagined, for example, first and second covers do not need to be bent to conform to the shape of the corresponding first and second frame elements or they can be partially bent to conform, or only one of the elements needs to be bent to conform.*" and on page 20, Appellant further states that the equivalence of the disclosed structure can be those that "... do not include fingers and have a bent cover; perhaps only have one finger on each side of the cover; or the covers are bent but are not bent to conform to the frames or wherein only one of the covers is bent." (emphasis added). Equally important, as noted above, claims that do not require multiple fingers are taken to be improper recapture of claimed subject matter.

(11) *Response to Argument*

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In view that Appellant has cancelled claim 21, the new matter regarding the proposed drawing correction is now purely confined to amendments to the specification/drawing. Review of the examiner's requirement for cancellation is by way of petition and NOT by way of appeal (see MPEP 608.04 (c)). It is suggested to submit Appellant's arguments on pages 6-8 by way of petition. Examiner's response to the arguments will be made once Appellant's petition is received.

In view of Appellant's argument on the bottom of page 7 to page 8 full paragraph 1 regarding the phrase "U-shaped configuration", the objection to the specification under 35 USC 132 is withdrawn.

In response to Appellant's argument on pages 8-9 regarding claims 26-27, it should be pointed out that these claims were objected because Appellant originally argues in Paper No. 14 on page 13 that "... *this use of means plus function language [referring to the means for securing language of claim 25] refers to the structure shown in the specification.*" (phrase inserted; emphasis added). If this is the case, then it is unclear how claims 26-27 would further limit claim 25 because Appellant argues that the "*means for securing ...*" is referring to the specific embodiment taught in the specification. In any event, in light of Appellant's newly presented argument which indicates that the means plus function language also includes the "*equivalents*" of the structure describe in the specification, the objection to claims 26-27 under 37 CFR 1.75(c) is withdrawn.

In response to Appellant's argument on page 11 to page 12, regarding *In re Rasmussen* and *In re Peters*, Examiner agrees that Appellant is entitled to claim as broad as prior art and

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original disclosure will allow. It should be pointed out, however, the determination on whether one is entitled to broaden the claimed subject matter is fact specific. The fact pattern in both of these cases may not be appropriate for the present case. In the present case, the original disclosure of the application relied upon does not reasonably convey to the artisan that the inventor had possession at that time of the later claimed subject matter. For example, the independent claims now require "*at least one finger*" as opposed to having "*fingers*". This broadened limitation is not sufficiently supported in the original disclosure because the original disclosure is completely silent on using a finger. In fact, as repeatedly noted above, Appellant in Application 08/092,012 Paper No. 6 stresses the criticality of providing multiple fingers to each cover. Note for instance, Appellant stated on pages 3-4 that "*The technique includes the use of protruding metallic fingers on the cover ... The present invention accomplishes this by means of the multiple fingers 26 ...*" (emphasis added). To further emphasize the importance of using multiple fingers, Appellant also submitted two separate declarations made by Mr. Paul Mercadante and Mr. Mark Moshayedi in Paper No. 7. In these declarations, it was stated in numbered paragraph 4 that "*Duel's product's superiority over the other available products is due to the unique construction of the cover halves which interperses a plastic frame within the metal elements or cover. This allows assembly of the package far more rapidly than with other products, and yields a superior package result.*" (bold face and emphasis added).

In response to Appellant's argument regarding claims 7 and 11 on pages 12-13, it is submitted that the original disclosure does not provide sufficient support to claim "*at least one*

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finger” for reason set forth immediately in the preceding paragraph. As for figure 3, it clearly illustrates multiple fingers, as opposed to having a single finger.

In response to Appellant’s argument on page 13 regarding the use of transitional phrase “comprising”, if Appellant’s argument holds true, then one can basically add almost any elements, not disclose, in the original disclosure. For instance, would it then be acceptable (i.e. no New Matter is added) to now require the metal covers to have an embossed surface for decorative purpose or provide a protective gold/platinum plating on the metal coverings because claims 9 and 16 use a transitional phrase “comprising”?

In view of Appellant’s argument on page 14 regarding claim 18, the rejection of this claim with regard to the limitation of having a “generally U-shaped configuration” is withdrawn. However, claim 18 stand rejected under 35 USC 112 1st paragraph for reasons set forth above.

In response to Appellant’s argument on page 16 regarding claim 24, Appellant may be entitled to claim broader than the specific embodiment shown in the specification as long as “*the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter*”, In re Ralston 227 USPQ 177. Here, it appears that Appellant did not have possession at that time of the later claimed subject matter of broadly requiring covers having fingers without specifying the number of sides which have the fingers. For instance, this claim now reads on a cover with fingers to all sides.

In response to Appellant’s arguments on page 16 regarding the use of “means plus function”, it is submitted that the original disclosure fails to convey to one in the art that

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Appellants has possession, at the time the invention was made, the "equivalents" of the originally disclosed structure. It is interesting to note, according to Appellant, *"A variety of equivalents to the disclosed means structure could be imagined, for example, first and second covers do not need to be bent to conform to the shape of the corresponding first and second frame elements or they can be partially bent to conform, or only one of the elements needs to be bent to conform."*

It is submitted that all the above cited structure is not sufficiently supported in the original disclosure. As for Appellant's argument that *"the Examiner's rejection would appear to preclude a patentee from ever using means for claims"*, Examiner strongly disagrees. A patentee can always use means for claims language if they are originally submitted claims or if the original disclosure reasonably conveys to one in the art that the "equivalents" of the preferred structure are also taught in the original disclosure.

In response to Appellant's arguments on page 12 regarding claims 22-23, the edge of a cover that is partially embedded may also prevent the separation of the covers and the frame elements. However, this is not the issue. The issue here, is whether or not the original disclosure provide sufficient support of injection molding partially around the edge. As clearly shown in figure 4, the bent edge is fully embedded by the frame element and NOT partially embedded as now claimed.

In response to Appellant's argument on pages 17-18 regarding the submitted declaration, it is submitted that adjunct Professor Wingfield may be an expert in this field. However, Professor Wingfield is not more than a lay person in terms determining whether a subject matter raise an

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issue of New Matter as stated under 35 U.S.C. 112 1st paragraph. Moreover, it would appear that Professor Wingfield only presented conclusory statements and arguments without providing a legal basis and objective evidence for his conclusion. Note, Appellant's argument regarding the structure of the cover having a generally U-shaped configuration, such is moot in view that the rejection is withdrawn.

In response to Appellant's argument regarding claim 28, such is moot because the rejection to this claim is withdrawn.

In response to Appellant's arguments on pages 18-19 regarding the 112 2nd paragraph rejection, such is moot in view that the rejection is withdrawn.

In light of Appellant's argument on page 20, the 102 rejection of claim 25 is withdrawn.

In response to Appellant's argument on pages 20-21 regarding the recapture rule, it should be emphasized that to determine whether there is an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based, it is imperative to review the record of the parent (S.N. 08/092,102) of this reissue application as a whole; NOT just narrowly review the last added limitations, which place the application in condition for allowance. Equally important, MPEP 1412.02 states that "*The Court in Hester held that the surrender which forms the basis for impermissible recapture 'can occur through arguments alone.'*" 142 F.3d at 1482, 46 USPQ2d at 1649." (quotation in original).

As correctly noted by Appellant on the bottom of page 3 in Paper No. 14, the previous Examiner added in an Examiner's Amendment "*each cover having a first side and a second side*

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with a plurality of fingers extending from said sides and wherein edges of the metal covers are bent to conform to the shape of the frame and said fingers are embedded in (emphasis added) to place the application in condition for allowance. Note that in the Examiner's amendment, it requires "*fingers*" as opposed to "*finger*"; the fingers extending from first and second sides as opposed to "*at least two sides*"; and the "*fingers are embedded in*" as opposed to partially embedded or being "*injection molded partially around the edge*" (emphasis added). Moreover, in Paper No. 6 dated 08-08-99, responding to Examiner's office action, Appellant replaced claim 1 with claim 16 to include "the plastic frame elements being injection molded around a plurality of fingers" (emphasis added), and then argues on pages 3-4 the criticality of injection molding and "protruding metallic fingers" (emphasis added) to the invention. Accordingly, "*The technique includes the use of protruding metallic fingers on the cover ... The present invention accomplishes this by means of the multiple fingers 26 ...*" (emphasis added). To further emphasize the importance of using multiple fingers, Appellant also submitted two separate declarations made by Mr. Paul Mercadante and Mr. Mark Moshayedi in Paper No. 7. In both declarations, it was stated in numbered paragraph 4 that "*Duel's product's superiority over the other available products is due to the unique construction of the cover halves which interperses a plastic frame within the metal elements or cover. This allows assembly of the package far more rapidly than with other products, and yields a superior package result.*" (bold face and emphasis added). Therefore, it is submitted that removing these limitations constitutes an improper

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recapture of claimed subject matter deliberately cancelled in the application for the patent upon which the present reissue is based.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



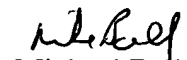
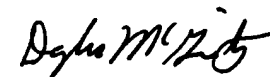
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November 2, 2000



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